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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,782	12/04/2003	Timothy C. Ostwald	03-045-TAP (STK 03045 PUS	7103
51344	7590	09/06/2006	EXAMINER TUPPER, ROBERT S	
BROOKS KUSHMAN P.C. / STK 1000 TOWN CENTER, TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238			ART UNIT 2627	
			PAPER NUMBER	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,782

Applicant(s)

OSTWALD ET AL.

Examiner

Robert S. Tupper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election without traverse of the invention of Group I, and the species of figures 4-7, stating claims 1-16 to read thereon, in the reply filed on 7/31/06 is acknowledged.

2. Claims 17-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/31/06.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has only described the concept of housing the picker in a module that can be separately attached and detached from a storage library.

Applicant has not disclosed the many structural features required to make that concept into an actual operational device.

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For example (and this is not intended to be all encompassing) there is no disclosure of the structural features required to accurately move the picker to, and maintain it at, a selected level to extract a cartridge, or insert an extracted cartridge into a drive, or to extract a cartridge from a drive, or to place a cartridge back into a cell. Clearly very precise control of the exact location of the picker is required to insure that the picker can grab a cartridge without causing damage by hitting some surrounding object. The specification acknowledges that the picker is suspended by cables (for the elected species) and is “free-hanging” (see page 13 lines 11-12). Nothing in the disclosure addresses issues related to this – e.g. the motions generated by movements of the hand assembly, or movement between levels, etc.

The lack of any disclosure of such structural details means that the public will have to unduly experiment to determine these structural details to produce an operational device.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 10, the recitation that of the robot assembly “being containable within a module/housing” is indefinite. This does not require that the presence of a module/housing or that the robot actually be within the module/housing.

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In claims 1, 5-7, 10, and 13-15, the recitation that the module/housing be "removably mountable" is indefinite. First, as noted above, there is no requirement that a module/housing even be present. Further, there is no recitation of the structural features that provide the removable mounting. This is merely a functional statement of possibility.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5, 7, 8, 10, 11, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by DANG (5,546,366).

Note especially figure 3. DANG shows storage device with a picker (38) that is capable of the possible functions stated in these claims. The picker module is read as the structures shown in figure 3 plus the top and bottom cross frame pieces (not shown). That module is capable of being removably mounted and dismounted. Note that these claims do not recite and structural features for the removable mounting and dismounting to define over DANG.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 6, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DANG (5,546,366).

DANG shows a storage library with picker substantially as claimed.

DANG differs in not: (A) utilizing a "new" robot assembly (re claims 4 and 12), and (B) showing the picker module located at the back of the frame (re claims 6 and 14).

Concerning (A), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a "new" robot assembly. The motivation is as follows: it is well known and commonly done to replace one mechanical part with a "new" part for maintenance or repair.

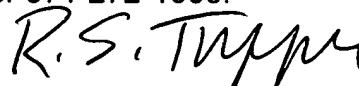
Concerning (B), it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the picker module at the back. The motivation is as follows: front and back would be art recognized equivalents that operate in the same manner and produce the same results without any unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S. Tupper whose telephone number is 571-272-7581. The examiner can normally be reached on Mon - Fri, 6:30 AM - 4:00 PM (first Fri off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert S Tupper
Primary Examiner
Art Unit 2627

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